

29 November 2012

PATENTS ACT 1977

APPLICANT Kevin McIntyre

ISSUE Whether the request to reinstate patent application number GB1005762.8 should be allowed under Section 20A and Rule 32(1)

HEARING OFFICER G.J Rose'Meyer

DECISION**Introduction**

- 1 Application GB1005762.8 was filed on 7 April 2010 in the name of Kevin McIntyre (the applicant) and was published on 1 December 2010.
- 2 The application proceeded until 17 May 2011, when the Office sent the applicant a reminder to his registered address for service in the UK (the applicant being resident in Australia) that if he wished to continue with the application, the request for a substantive examination should be filed on a Patents Form 10 (Request for a substantive examination) with the prescribed fee of £100.00 on or before 1 June 2011, unless a request to extend that time by two months was made at the additional cost of £135.00.
- 3 The Form 10 was not filed by the due or extended date and was duly terminated with effect from 2 June 2011.
- 4 On 19 December 2011 the applicant rang the Office to enquire as to the status of the application. He was advised that he needed to file a Form 14 (Request to reinstate a patent application) with a fee of £150.00 to apply for reinstatement. The same day a letter detailing how to apply for reinstatement was sent to Mr McIntyre as an attachment to an email. The covering email explained that if Mr McIntyre wished to apply for reinstatement, the request must be filed by 20 February 2012.
- 5 On 1 March 2012 the Office received by fax a Patents Form 14 along with its prescribed fee of £150.00 and an accompanying letter explaining the circumstances surrounding the lapse of the application.
- 6 On 7 March 2012 the Office wrote via email to Mr McIntyre saying that based on the evidence he had filed to date, the case for reinstatement of the application had not been satisfactorily made and giving him the opportunity to submit further observations or evidence if he so wished. It also gave him the opportunity to appoint

a new address for service in the UK as he had indicated in his previous letter that he was not satisfied with the forwarding of correspondence arrangements from his previous address for service.

- 7 The applicant subsequently took up the offer to file further evidence and to appoint a new address for service.
- 8 After consideration of the further evidence, the Office issued a letter dated 11 May 2012 offering the preliminary view that a sufficient case for reinstatement had still not been made out and therefore offering the applicant a telephone hearing (in the circumstances that the applicant wished to represent himself from Australia) if he so wished. This offer was subsequently taken up.
- 9 The matter therefore came before me at a telephone hearing on 17 September 2012. Mr McIntyre was represented by Mrs. Margaret A. Deary, a part-owner of and marketing consultant to his business.
- 10 At the hearing Mrs. Deary made her submissions in support of the application for reinstatement but also requested some further time in which to submit further evidence to answer some questions I put to her at the hearing. I allowed her until 1 October 2012 to submit further submissions.

The evidence

- 11 The evidence filed in support of the application for reinstatement comprised of the following:
 - A faxed letter received by the Office on 1 March 2012 accompanying the Form 14 request for reinstatement.
 - An email sent on 3 May 2012 from a Mr Gregory Lenehan, a colleague of Mr McIntyre, attaching a letter dated 30 April 2012 from a Dr. Minh Vu, containing some medical details about Mr McIntyre.
 - An email sent 1 October 2012 from Margaret Deary as a result of additional time allowed at the hearing to file further submissions.

The Office's case

- 12 The office's case in short was set out in the official letter of 7 March 2012. This stated that the request to reinstate the application in suit was not filed in time as prescribed by rule 32(2)(a) of the Patent Rules 2007.
- 13 Having arrived at this view, the Office has not gone on to state its position on whether the failure to comply with a requirement of the Act was unintentional or not.

The applicant's case

- 14 The applicant's case in short is that it was always his intention to continue with his patent application and to file the request for substantive examination in time, but due to official letters not being forwarded to him from his address for service in the UK, he was never aware of the deadline to do so. He argues that the failure was completely unintentional.
- 15 It was because of this lack of activity on his application that Mr McIntyre rang the Office himself on 19 December 2011. Mr McIntyre and his representatives Mr Lenehan and Mrs Deary acknowledge that as a result of that phone call, the Office did avail Mr McIntyre of the date by which he had to file his request for reinstatement, but argue that Mr McIntyre misunderstood the date initially and was further confused in a subsequent telephone conversation with the Office, causing him to misunderstand the date again, leading to eventually filing the request too late. They argue the misunderstandings and confusion on Mr McIntyre's part was caused by on-going medical conditions.

The law

- 16 The provisions for reinstatement of patent applications are set out in Section 20A of the Act and Rule 32. The relevant parts of Section 20A state:

Section 20A. – (1)

Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is-

(a) Set out in this Act or rules, or

(b) specified by the Comptroller

(2)the Comptroller shall reinstate the application if, and only if –

(a) the applicant requests him to do so;

*(b) the request complies with the relevant requirements of the rules;
and*

(c) he is satisfied that the failure to comply referred to in subsection(1) above was unintentional

(3) – (9)

Rule 32 states –

32. (1) A request under section 20A for the reinstatement of an application must be made before the end of the relevant period.

(2) For this purpose the relevant period is –

(a) two months beginning with the date on which the removal of the cause of non compliance occurred; or

(b) if it expires earlier, the period of twelve months beginning with the date on which the application was terminated.

(3) The request must be made on Patents Form 14.

(4) Where the comptroller is required to publish a notice under section 20A(5), it must be published in the journal.

(5) The applicant must file evidence in support of that request.

The issues to be determined

- 17 In effect the first determination to be made under s20A is whether the reinstatement request complies with the requirements of Rule 32.
- 18 In order to do this, the first issue I need to address is to identify the applicant's specific failure to comply with a requirement of the Act or rules within a time limit which had the direct consequence that the application was either refused or treated as having being refused or withdrawn.
- 19 Having established this, I then need to determine whether the request for reinstatement complies with the requirement of rule 32(1) to be filed within the time periods prescribed by that rule.
- 20 Only if I determine it was, do I then need to decide whether the failure to comply was unintentional under s.20A (2) (c).

Analysis and arguments

What was the failure to comply?

- 21 The application was initially treated as withdrawn as a consequence of the applicant's failure to comply with the time period prescribed for filing the request for substantive examination on a Form 10 – Rule 28 (1) and (2). In this case that time period was that the Form 10 needed to be filed by 1 June 2011. The Form 10 was not filed by this date and no request to extend that date was received.
- 22 These facts were not disputed by the applicant.
- 23 Therefore my finding here is straightforward in that the failure of the applicant was in not filing the Form 10 asking for substantive examination of the patent application in suit, along with its prescribed fee by the due date of 1 June 2011.

Was the request for reinstatement filed in time?

- 24 The applicant requested reinstatement on 1 March 2012. The issue of whether this meets the requirements of rule 32(2) has to be established before I can go any further.
- 25 Rule 32(1) prescribes that the request must be made before the end of *the relevant period*. Rule 32(2) then sets out *the relevant period* as the first to expire of two possible options. These are:
- Rule 32(2)(a) which prescribes that the request shall be made before the end of “*two months beginning with the date on which the removal of the cause of non compliance occurred*” and
 - Rule 32(2)(b) which prescribes that the request shall be made before the end of “*the period of twelve months beginning with the date on which the application was terminated*” if that period expires earlier.
- 26 Dealing with rule 32(2)(b) first, the effective date of termination of the application referred to in this case was the day after the Form 10 and fee should have been filed i.e. 2 June 2011. This would put the date referred to in rule 32(2)(b) by which the request had to be made as 2 June 2012. The request in this case was made on 1 March 2012 which is clearly within the twelve months referred to in that rule.
- 27 However, the relevant date must be the first of these two options and rule 32(2)(a) sets out the relevant period as ‘*two months beginning with the date on which the removal of the cause of non compliance occurred*’. Therefore to determine which date is the earlier I need to determine the date of the removal of the cause of non compliance to see if that date was earlier than the date under rule 32(2)(b).

What was the cause of the non-compliance?

- 28 In order to decide the date when the cause of non compliance was removed, I firstly needed to consider what that cause was. In essence, the applicant’s explanation was that he failed to file the Form 10 on time because he was not aware of the deadline to do so because official correspondence was not being forwarded to him from his registered address for service in the UK. In essence what this means is that Mr McIntyre was unaware of what he had to do or by when he had to do it. This therefore is the cause of the non compliance.

What was the date of the removal of the cause of non compliance?

- 29 The applicant explained in his letter of 1 March 2011 that he telephoned the Office on 19 December 2011 to find out about the progress of his application. In that conversation, he was told that his application had been terminated because he had not filed his Form 10 and its fee. In order to rectify this he was also told he could apply for reinstatement and this was confirmed in an email and attached letter the same day. The email stated that the request for reinstatement should be filed by 20 February 2012.

30 It appears clear based on these events that Mr McIntyre was made aware of his non compliance in not filing the Form 10 and its fee in his phone call to the Office on 19 December 2011 and on the same date he was told what he would have to do to rectify the situation. On the face of it this is the date on which the cause of the non compliance was removed and therefore to abide by rule 32(2)(a), the request for reinstatement of the application had to be made before 20 February 2012. The Office even confirmed this by email on the same day as Mr McIntyre's phone call.

31 However, at the hearing I asked Mrs Deary what had caused Mr McIntyre to become confused over the date by which to request reinstatement? I asked this because of two specific extracts from his letter of 1 March 2012. I will reproduce these below:

"The time period for this request was 2 months. I interpreted this as being a calendar month which meant it fell due today being 01/03/12,"

"...after placing a call to the UK I.P.O to ask for some guidance re making a credit card payment, I was informed that the 2 months actually expired on 20/02/12."

32 Given that the first extract refers to information provided to Mr McIntyre in a phone conversation on 19 December 2011, the reference to "calendar month" and "01/03/12" appear to make very little logical sense given this does not appear to have been said to him and even if it had been, it still would not have led to a date of 1 March 2012. This of course leaves aside the fact the office's email confirmation specifically gave the date as being 20 February 2012.

33 Mrs Deary's explanation at the hearing was essentially that Mr McIntyre is an elderly and not a very well man, as the evidence from Dr Minh Vu shows, and that he is easily confused and forgets things very quickly, even if he understands things at all in the first place. His age, medical conditions and the stress these cause him, contribute greatly to the significant impairment of his concentration and memory levels. I accept these points as they are confirmed in Dr Minh Vu's evidence.

34 On the second extract, I was unsure as to what telephone call Mr McIntyre referred. Was this the same call as the one on 19 December 2011 or a subsequent one? At the hearing I explained the importance of this date – i.e. I needed it in order to determine whether his application for reinstatement was filed in time, because if it was not, there will be no reinstatement application to consider further.

35 Mrs Deary did not know the answer at the hearing, but asked for time to find out. This I allowed and she submitted a further email on 1 October 2012 stating that having spoken to Mr McIntyre and to his assistant, they confirm that the phone call referred to in the second extract was made on 5 January 2012. She states that Mr McIntyre's assistant was present when the call was made to the UK and that in the call Mr McIntyre was told again that he had two months in which to request reinstatement, which led him to believe he had until 5 March 2012. Hence that was why he had filed the Form 14 and fee on 1 March 2012.

36 It is clear that the *earlier* of the two relevant dates envisaged by rule 32(2) will be the one I establish from this evidence. Whether the date the non compliance was removed was 19 December 2011 or 5 January 2012, projecting forwards the two

months prescribed in rule 32(2)(a) will be earlier than the twelve months from the date of termination prescribed by rule 32(2)(b) – i.e. 2 June 2012.

- 37 Given the evidence filed about Mr McIntyre's medical conditions and the effect these have on his memory and concentration and the entirely convincing submissions I heard from Mrs Deary at the hearing, I am satisfied that the applicant was sufficiently confused to forget the date initially told to him by which he should file his request for reinstatement – i.e. by 20 February 2012. This date was clearly confirmed to him in writing by the Office, but there is nothing in the evidence on file or from the submissions I heard at the hearing which suggests to me Mr McIntyre registered or certainly retained this as being the crucial date at all. In these circumstances, I think it is reasonable to conclude that the cause of the non compliance had still not been removed as at 19 December 2011.
- 38 I am fortified in this view by the fact that it seems to me that he still remained somewhat confused even after his telephone conversation to the Office on 5 January 2012, because he says in his letter of 1 March 2012 that he was told again "*after placing a call to the UK I.P.O to ask for some guidance re making a credit card payment ... that the 2 months actually expired on 20/02/12*".
- 39 However, in her evidence dated 1 October 2012, Mrs Deary says Mr McIntyre understood from that conversation that he had until 5 March 2012. This she states is verified by Mr McIntyre's assistant who was present at the hearing. Based on this evidence, it seems that whatever he states he was told, Mr McIntyre's ultimate understanding on 5 January 2012 was that he had two months from the date of that conversation in which to file the request for reinstatement.
- 40 On the face of it that understanding was illogical given the clarity with which the office had stated what the date for reinstatement was. However, given the medical evidence – which of course was not available to the office at the time Mr McIntyre first rang - I think the assumption made by the office when he rang for a second time that the 20 February 2012 date for filing the reinstatement was correct, was in itself wrong. It was a perfectly reasonable assumption at the time, but the subsequent evidence shows how and why that date was not understood or retained by Mr McIntyre.
- 41 In my view the date by which the reinstatement had to be filed was as yet undetermined at the point where Mr McIntyre rang the office on 5 January 2012. It was only after that conversation had concluded with the understanding Mr McIntyre took from it and shared with his assistant, that the cause of the non compliance was finally removed.
- 42 There is still a question in my mind as to why having been told on 5 January 2012 that he had two months to file the reinstatement and given that the original reason for the call was an enquiry about credit card payments, why Mr McIntyre or his assistant did not file the requisite Form 14 (Request to reinstate a patent application) and fees immediately or soon after? However, that is not a matter the evidence resolves.
- 43 I conclude that in the very particular circumstances of this case I am content to decide that the date on which the removal of the cause of non compliance actually occurred was 5 January 2012. As such the applicant had two months from that date

under rule 32(2)(a) (i.e. by 5 March 2012) in which to make the request for reinstatement. That request was made on 1 March 2012 and as such is clearly within the period of two months allowed by r.32(2)(a).

Was the failure to comply unintentional?

- 44 Having decided that the application for reinstatement of the application was made in time the only issue remaining for me to decide is whether the failure to file the request for substantive examination meets the requirements of section 20A (2)(c) of the Act i.e. "*the Comptroller shall reinstate the application if, and only if - he is satisfied that the failure to comply was unintentional*".
- 45 The Office has not stated its position on this, but I have assessed all the evidence before me.
- 46 It is important that the meaning of the requirement is read and understood in totality. It is tempting to merely look at the word "unintentional" and decide whether the evidence demonstrates that the circumstances surrounding the facts of the case were unintentional. This is not the test. The determination is not to be reached by examining and making a judgement of the general surrounding circumstances but rather what the reasons were in specific relation to the failure to comply (in this case not filing the Form 10 in time) and then whether that failure was unintentional.
- 47 Mr McIntyre has stated in his evidence that it was never his intention to let this patent application lapse, but it has been established that simply having an underlying intention to proceed with the application does not prove that the failure to comply with the requirement was unintentional (see *Sirna Therapeutics Inc's Application* [2006] RPC 12 and *Anning's Application* (BL O/374/06).
- 48 I have already established that the failure of the applicant was in not filing the Form 10 asking for substantive examination of the patent application in suit, along with its prescribed fee by the due date of 1 June 2011. Furthermore I have already accepted that the reason for that was because he was not aware of the deadline to do so because official correspondence was not being forwarded to him from his registered address for service in the UK.
- 49 Mr McIntyre had correctly appointed an address for service in the UK and the evidence shows that he had emphasised the importance of forwarding any of his mail relating to the patent application in suit on to his Australian address. It is also clear from the evidence that this did not happen. That was clearly not Mr McIntyre's intention when acting correctly in appointing and instructing his address for service in the UK.
- 50 From the evidence I find that the applicant's failure to file the Form 10 in time was clearly not a conscious decision on his part and resulted from the unintended inaction of a properly appointed and instructed third party. As such the failure to comply was clearly unintentional.

Conclusion

- 51 On the evidence put before me, I am satisfied that the applicant filed the application for reinstatement within the period prescribed by rule 32(2)(a).
- 52 I am also satisfied that the failure to file the Form 10 asking for substantive examination of the patent application in suit and its prescribed fee by the due date was unintentional and therefore that the requirements of section 20A (2) have been met and that reinstatement should be allowed.
- 53 I hereby order that this application be reinstated

G.J. Rose'Meyer
Hearing Officer
Acting for the Comptroller